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## PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

UTL 00015

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Typed or printed name \_\_\_\_\_

Application Number

09/848,070

Filed

May 3, 2001

First Named Inventor

FOK, Kenny K.

Art Unit

2617

Examiner

DANIEL, Jr., Willie J.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.  
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.  
(Form PTO/SB/96)

☒ attorney or agent of record. 50,519  
Registration number \_\_\_\_\_

☐ attorney or agent acting under 37 CFR 1.34.  
Registration number if acting under 37 CFR 1.34 \_\_\_\_\_

/George W. Luckhardt/

Signature

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Typed or printed name

858-882-2593

Telephone number

October 19, 2007

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below\*.

☒ \*Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant(s): <b>FOK, Kenny K.</b>	Group Art Unit: <b>2617</b>
Application Serial No.: <b>09/848,070</b>	Examiner: <b>DANIEL Jr., Willie J.</b>
Filed: <b>May 3, 2001</b>	Conf. No.: <b>7836</b>
Title: <b>INSTANT MESSAGING TO A MOBILE DEVICE</b>	

Mail Stop AF  
Commissioner for Patents  
P.O. Box 1450  
Arlington, VA 22313-1450

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Dear Sir/Madam:

The Applicant respectfully submits the following Pre-Appeal Brief Request for Review in response to the Final Action mailed July 24, 2007. Applicant believes the request is timely filed within three months of the mailing of the Action. Please enter the following Pre-Appeal Brief Request for Review and accompanying remarks.

**Remarks/Arguments** begin on page 2.

**REMARKS**

The Applicant respectfully request a Pre-Appeal Brief Request for Review to evaluate the Examiner's omission of one or more essential elements necessary to sustain a *prima facie* 35 U.S.C. §103 rejection of claims 50-62 based Carey et al. (United States Patent No. 6,714,793) in view of Gudjonsson et al. (United States Patent No. 6,564,261), in further view of Polychronidis (United States Patent No. 7,020,685); alternatively, in view of Guedalia et al. (United States Patent No. 7,043,538); alternatively, in view of Chen et al. (United States Patent No. 7,020,685), in further view of Polychronidis.

**A. Claim Rejections under 35 U.S.C. § 103:**

The Action rejects claims 50-56 as being unpatentable over Carey et al. (United States Patent No. 6,714,793) in view of Gudjonsson et al. (United States Patent No. 6,564,261), claims 57-62 as being unpatentable over Carey in view of Gudjonsson, in further view of Polychronidis (United States Patent No. 7,020,685) and claims 50 and 57 as being unpatentable over Carey et al. (United States Patent No. 6,714,793) in view of Guedalia et al. (United States Patent No. 7,043,538); alternatively, in view of Chen et al. (United States Patent No. 7,020,685), in further view of Polychronidis. Applicant believes that each of the rejections fails to make out a *prima facie* case of obviousness with respect to all of the claims and are therefore clearly in error.

Specifically, claims 50-62 are directed to a system in which a "proxy server" or any other type of server can maintain the presence information of the wireless communication device with an instant messaging service such that the

wireless communications device appears “online” even when in fact there is NO “data connection” between the wireless communication device and the wireless network. Prior art systems, including those described in the art cited in the Action, simply do not make a wireless device appear online, without a data connection to the device.

Accordingly, in contrast with independent claim 50, Carey et al. fails to teach or suggest a proxy server for “...**transmitting presence information** to the instant messaging service to indicate that the wireless communications device is online **even when a data connection does not exist** between the wireless communication device and the wireless network....” Prior Actions acknowledge the Carey et al. reference does not teach this limitation (See non-Final Office Action of February 6, 2007).

Gudjonsson et al. fails to cure the deficiencies of Carey et al. The sections (col. 7, line 53 – col. 8, line 30; col. 8, lines 53-65, col. 11 lines 32-64) of Gudjonsson et al. offered by the Action merely teach connection servers (col. 8, lines 19-21) that provide services such as: storing “presence data” associated with a user on a database (col. 8, lines 54-56), publishing dynamic user status information **to indicate** “whether the user is currently online on his/her PC or not” (col. 8, lines 57-60), and providing users with the ability **to check** whether other users are connected to the same connection servers are online (col. 8, lines 61-63).

Similarly, Polychronidis also fails to cure the deficiencies of Carey in light of Gudjonsoon. Polychronidis merely teaches a push or pull agent that accepts

queries for presence/location information from an application. (See pg. 3, paragraph 34-35, 37.) The pull agent then queries the Home Location Register (HLR) of the wireless network for the requested information, and relays this information to the to the application. (Id.)

Guedalia et al. also fails to cure the deficiencies of Carey et al. Guedalia et al. merely teaches a presence server that “maintains an active session” with an external server (i.e., instant messaging service) even when a user is disconnected from the presence server (col. 5, lines 4-10). There is no teaching or suggestion in Guedalia et al. that the presence server “actively” transmits presence information to the external server (i.e., instant messaging service) to fool it into thinking that the user (i.e. wireless communications device) is online even when he/she is disconnected from the presence server. The fact that an “active session” is maintained by the presence server cannot be inferred to mean that the presence server is actively transmitting presence information to the external server. They are mutually exclusive concepts.

Chen et al. also fails to cure the deficiencies of Carey et al. The section cited in the Action on Chen et al. (col. 1, lines 63-65 and FIGs 1 and 4) merely teaches that a proxy server, between a wireless device and one or more network servers, can facilitate the transmission of SMS messages. Chen et al. is completely silent as to the proxy server having any capability of actively transmitting presence information to the one or more of the network servers to indicate that the wireless device is online even when the wireless device is disconnected from the proxy server.

For at least the above reasons, the Applicant respectfully believes that the rejection of claim 50 is in clear error and that claim 50 is in condition for allowance. Claims 51-56 depends directly or indirectly off of claim 50. Accordingly, the Applicant respectfully submits that claims 50-56 are in condition for allowance.

In contrast with claim 57, as amended, Carey et al. fails to teach or suggest a “proxy server determining that the wireless communications device is in the active message state status if the wireless communications device is responsive to a special SMS message that is periodically sent by the proxy server to the wireless communications device” (See Applicant’s Claims and Specification, page 12, lines 19-23). Specifically, Carey et al. is completely silent as to a “proxy server” that can periodically send special SMS messages to a wireless device, and based on the response, determine whether the wireless device is in an active state.

Gudjonsson et al., Guedalia et al., Polychronidis ,and Chen et al. all fail to cure the deficiencies of Carey et al., as they are also completely silent as to this particular feature.

For at least the above reasons, the Applicant respectfully believes that the rejection of claim 57 is in clear error and that claim 57 is in condition for allowance. Claims 58-62 depend directly or indirectly off of claim 57. Accordingly, the Applicant respectfully submits that claims 57-62 are in condition for allowance.

**C. CONCLUSION**

For all the foregoing reasons, allowance of claims 51-62 pending in the present application is respectfully requested.

Respectfully Submitted,

Dated: October 4, 2007

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